Supreme Court, U.S.
FILED
DEC 24 1996
CLERK

(2)

No. 96-851

IN THE
Supreme Court of the United States

OCTOBER TERM, 1996

SUSAN M. MAXWELL,

Petitioner,

v.

J. BAKER, INC.,

Respondent,

AND

PRANGE WAY, INC.

Defendant.

ON PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

RESPONDENT'S BRIEF IN OPPOSITION

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RESPONDENT'S BRIEF IN OPPOSITION

Respondent, J. Baker, Inc. ("J. Baker"), requests that this Court deny the petition for writ of certiorari seeking review of an opinion of the United States Court of Appeals for the Federal Circuit in this case reported at 86 F.3d 1098 (Fed. Cir. 1996).

Under the circumstances presented here, there is no sound reason for review in this Court. Contrary to petitioner's suggestion, the Federal Circuit did not fashion a "new" rule of law in this case. Rather, it applied well-settled principles, long rec-

ognized by this Court, in ruling that petitioner could not assert a patent infringement claim against a device that had been disclosed in the specification of her patent but never claimed as part of her invention. Such unclaimed public disclosure has long been held to be a dedication to the public, as the Federal Circuit correctly ruled. The issue presented here is settled, and plaintiff's assertions of conflict with the decisions of this Court or of the Federal Circuit are unfounded. That is why this case involves a unanimous decision by the Federal Circuit panel, and a denial of rehearing *en banc* in which no active Federal Circuit judge asked for a poll on rehearing.

Moreover, the decision below was manifestly correct. The rule followed by the Federal Circuit forces patent applicants to identify their inventions *in the claims of the patent* where they will be subject to the expert review of the Patent and Trademark Office (the "PTO"). As the Federal Circuit correctly recognized, the contrary rule advocated by petitioner would encourage patent applicants to draft their claims narrowly to avoid such scrutiny, while disclosing broader technology in their specifications in the hope of convincing a jury to grant patent protection under the doctrine of equivalents. Such a course fundamentally undermines the American claims-based patent system that depends on careful PTO scrutiny of claims, not specifications. Where, as here, the patentee has led the public to conclude that she deliberately declined to claim the subject matter disclosed in the specification, the public has a right to take the patentee at her apparent word.

Finally, there is no merit to petitioner's suggestion that proper disposition of this petition should await this Court's decision in *Warner-Jenkinson Co.* v. *Hilton Davis Chemical Co.*, No. 95-728. The issued raised in the instant petition is not presented in *Warner-Jenkinson*.

For these reasons, as described more fully below, the petition for certiorari should be denied.

STATEMENT OF THE CASE

Rule 14.1(g) of the rules of this Court direct the petitioner to present "[a] concise statement of the case setting out the facts material to consideration of the questions presented." Petitioner here has disregarded this rule altogether and submitted instead a rehash of her jury summation, arguing contested evidence that has no bearing on the legal issue raised in the petition.

The disposition of the petition in this case turns entirely on the language of the patent at issue, its prosecution history and the course of proceedings below. J. Baker submits the following brief counterstatement of the case summarizing these matters.

Prosecution of the '060 Patent

Petitioner alleged that J. Baker infringed three claims of U.S. Patent No. 4,624,060 (the " '060 patent"), issued to petitioner in 1986. The language of claim 1, representative of the other two claims at issue, is quoted in the Federal Circuit's opinion. Pet. at A4-A5. Each of the claims describes a system for connecting mated pairs of shoes that involves stringing the shoes together through "tabs" or "loops" inside each shoe. Each claim is subject to the express limitation that the fastening tab be "secur[ed] between the inner and outer soles" of the connected shoes.

For petitioner to obtain patent protection at all, it was necessary for her to emphasize her specific location of the tabs to distinguish her system from the prior art.[1] The prior art identi-

[1] In distinguishing her invention from an earlier attempt to secure tabs to the interior side of the shoe, she stated to the examiner:

> [I]t is the securing means for the tab which secures a first part between inner and outer soles of a shoe and extends as a second part

fied by the patent examiner taught a variety of shoe connection systems using tabs attached to mated pairs of shoes in various locations, including tabs secured between the inner and outer soles on the outside of shoes (U.S. Patent No. 3,482,335 (Ornsteen)), tabs stitched into the interior side of the shoe close to the top edge (U.S. Patent No. 1,300,998 (Nelson)), and tabs secured between the inner and outer soles inside the shoe at the center of the soles (U.S. Patent No. 1,189,989 (Moore)).[2] Had she claimed a system with tabs located anywhere inside the shoes, she would have faced likely rejection in the face of this prior art.

Petitioner was aware of alternative locations for securing the fastening tabs when she filed her application. She disclosed in the specification of the '060 patent that "[a]lternatively, the tabs may be stitched into a lining seam of the shoes at the sides or back of the shoes." Critically for this case, however, she never included these alternatives in her claims.

Petitioner Attempts to Enforce the '060 Patent

Upon receiving notice of infringement in 1990, J. Baker immediately adopted alternative shoe connection systems that removed the tabs from between the soles at the side of the inner sole and stitched them into a seam at the shoe's "counterpocket" or "top line."[3] Petitioner insisted, however, that the

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> from the first part at the side edge of the innter [*sic*] sole upwardly along the inside surface of the shoe upper which is equally novel to any one particular type of aperture at the end of the second part of the tab.

(A. 3740).

[2] These patents are set and reproduced in J. Baker's brief as appellant in the Federal Circuit as Exhibits C, D. And E, respectively.

[3] The "counterpocket" of a shoe is the part of the lining in the rear of the shoe that "creates . . . a pocket for [the] heel." (A. 0548). The "top line" seam is the seam formed at the top edge of a shoe upper. (A. 1917). *See* Pet. at A4.

'060 patent covered shoes connected through tabs located anywhere in the interior of the shoe, despite the far narrower language of her claims.

Petitioner commenced an infringement action against J. Baker and a department store chain in which J. Baker leased and operated the shoe department.[4] With regard to the counter-pocket and top line systems, petitioner was permitted to argue to the jury that these alternatives infringed both literally and under the doctrine of equivalents, and the question of claim construction was submitted to the jury, contrary to this Court's later ruling in *Markman* v. *Westview Instruments, Inc.*, 116 S.Ct. 1384 (1996). The jury found that the alternative systems infringed without specifying whether they found literal infringement or infringement by equivalents.

J. Baker moved for judgment as a matter of law after the verdict. The trial court allowed the motion to the extent that the court concluded that the alternative systems could not literally infringe as a matter of law based on the court's interpretation of the patent claims, because those systems plainly had no tab secured between the inner and outer soles.[5] The district court somehow divined, however, that the jury must have decided the case based on the doctrine of equivalents and found evidence sufficient to support such a verdict.

On appeal, the Federal Circuit ruled that petitioner's disclosure of the alternative systems in her specification had the effect of dedicating those alternatives to the public.[6] As a result,

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[4] The district court directed the entry of judgment for the department store, Prange Way, Inc., and petitioner did not challenge that ruling on appeal.

[5] The Federal Circuit affirmed this ruling and petitioner has not sought review of the Federal Court's decision in this respect by this Court.

[6] As a result of this ruling, the Federal Circuit had no occasion to consider or rule upon J. Baker's other arguments. The panel plainly did not reject these arguments, as petitioner inaccurately argues in her petition. Pet. at 6, 23. Specifically, the Federal Circuit did not rule upon J. Baker's arguments: (i) that infringement under the doctrine of equivalents could not be found because J. Baker's alternative

the court reversed the determination that J. Baker's alternative systems infringed.

Petitioner sought rehearing in banc. In her suggestion of rehearing in banc, petitioner advanced for the first time the argument that the panel's application of the "dedication to the public" rule reflected a change in established patent law and created undesirable disincentives to making comprehensive disclosures in patent specifications.

The Federal Circuit denied rehearing with no active judge requesting a poll on rehearing.

REASONS FOR DENYING THE WRIT

I THE DECISION OF THE FEDERAL CIRCUIT THAT PETITIONER HAD DEDICATED THE ALTERNATIVE SYSTEMS TO THE PUBLIC IS WELL-GROUNDED IN THE DECISIONS OF THIS COURT AND THE FEDERAL CIRCUIT AND IN THE FUNDAMENTAL STRUCTURE OF THE PATENT LAWS.

Petitioner's argument for review by this Court turns entirely on her assertion that the Federal Circuit in this case "has now attempted to create a new limit on the Doctrine of Equivalents." Pet. at 11. Petitioner is simply incorrect. The doctrine that unclaimed subject matter disclosed in the specification is dedicated to the public reflects well-settled principles of patent law long recognized by this Court and by the Federal Circuit and correctly applied in this case.

The starting point for analysis is that the U.S. patent system is claims-based. Section 112 of the patent statute requires paten-

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systems as a matter of law were too dissimilar to be equivalent, and (ii) that petitioner's unmistakable statements to the patent examiner emphasizing the specific location of her tabs established prosecution history estoppel as a matter of law. The court of appeals also did not have occasion to consider J. Baker's argument that because the trial judge did not instruct the jury as to the proper construction of the '060 patent, as this Court required in *Markman* v. *Westview Instruments, Inc.*, 116 S.Ct. 1384, 1395-96 (1996), J. Baker was entitled to a new trial on infringement.

tees to set forth "claims" at the conclusion of the patent that "particularly point[ ] out and distinctly claim[ ] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112. This Court has repeatedly and consistently emphasized that the claims of a patent determine the scope of the patentee's statutory rights. *See, e.g., Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271, 277 (1949) ("We have frequently held that it is the claim that measures the grant to the patentee."); *Milcor Steel Co.* v. *George A. Fuller Co.*, 316 U.S. 143, 145-46 (1942) ("claims . . . afford the measure of the grant to the patentee"); *Motion Picture Patents Co.* v. *Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917) ("It is to the claims of every patent . . . that we must turn when we are seeking to determine what the invention is").

In the same way, this Court has also recognized that that which is disclosed in a patent, but not claimed, is dedicated to the public. In *Miller* v. *Brass Co.*, 104 U.S. 350, 352 (1881), this Court stated that:

> the claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed.

In *Keystone Bridge Co.* v. *Phoenix Iron Co.*, 95 U.S. 274, 279 (1877), this Court observed:

> As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim; or, if broader, they must be held to have surrendered the surplus to the public.

The Federal Circuit has also adhered to the principle that disclosure in a patent of unclaimed subject matter constitutes a

dedication of that subject matter to the public. The leading case is *Unique Concepts, Inc.* v. *Brown*, 939 F.2d 1558, 1562-63 (Fed. Cir. 1991), which squarely held that "subject matter disclosed but not claimed in a patent application is dedicated to the public." *See also Environmental Instruments, Inc.* v. *Sutron Corp.*, 877 F.2d 1561, 1564 (Fed. Cir. 1989) ("The disclosure of a patent is in the public domain save as the claims forbid.").

The "dedication to the public" rule is fundamental to a claims-based system, as the court below correctly recognized. A device identified in a patent claim can be patented only after an independent expert examiner determines that the device satisfies the statutory standards of novelty, utility and non-obviousness. A failure to include subject matter in a patent claim precludes the examination of that subject matter. As the Federal Circuit has observed, "[a]n applicant should not be able deliberately to narrow the scope of examination to avoid during prosecution scrutiny by the [Patent and Trademark Office] of subject matter with the objective of more quickly obtaining a patent (or avoiding the risk of an estoppel), and then obtaining in court, either literally or under the doctrine of equivalents, a scope of protection which encompasses that subject matter." *Genentech, Inc.* v. *Wellcome Foundation Ltd.*, 29 F.3d 1555, 1564 (Fed. Cir. 1994). *See Unique Concepts*, 939 F.2d at 1562.[7]

In this respect, the "dedication to the public" rule is similar to the doctrine of prosecution history or "file wrapper" estoppel.

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[7] Petitioner's argument that the "dedication to the public" rule applies only as a limitation on literal infringement, Pet. at 17, makes no sense. *By definition*, unclaimed subject matter can *never* fall within the literal scope of the claims. If the rule does not operate to limit the doctrine of equivalents, it has no content. The correct principle was stated by this Court in *McClain* v. *Ortmayer*, 141 U.S. 419, 423-24 (1891): "Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that, if he only describe *and* claim a part, he is presumed to have abandoned the residue to the public." (emphasis added).

As this Court has recognized, a patentee may not recapture under the doctrine of equivalents subject matter surrendered or disclaimed during the prosecution of a patent. *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126, 136 (1942).[8] The subject matter surrendered is dedicated to the public in the sense that the patentee may not, as a matter of law, claim that it is encompassed within the scope of the patent. The public is entitled to rely on the patentee's disclaimer.

The patentee should not be entitled to any broader patent coverage if she drafts her claims narrowly from the outset. If, in this case, petitioner had claimed as her invention a system for connecting mated pairs of shoes through tabs located anywhere in the interior of the shoes, and, faced with a rejection, she had amended her claims to limit them to tabs secured between the inner and outer soles, then plainly she would have been estopped from claiming any other location as equivalent. Petitioner should fare no better where, as here, she made no effort to claim alternatives of which she was concededly aware and which directly implicated the prior art, and where she emphasized the precise location of the tabs between the inner and outer soles in distinguishing prior art to the examiner.

This is not a case in which a patentee has lost rights as a result of inartful claim drafting. The technology in this case is not complex. It would have been easy to draft claims without the limitation that the tabs be secured between the inner and outer soles. The conclusion is inescapable that the submission of narrower claims reflected the recognition by petitioner and her patent counsel that broader claims were most unlikely to be approved.

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[8] As the doctrine has been applied by the Federal Circuit, prosecution history estoppel arises not only by narrowing amendments, but also by "'[u]nmistakable assertions made by the applicant to the Patent and Trademark Officed (PTO) in support of patentability, whether or not required to secure allowance of the claim.'" *Wang Laboratories, Inc.* v. *Toshiba Corp.*, 993 F.2d 858, 867 (Fed. Cir. 1993) (quoting *Texas Instruments, Inc.* v. *ITC*, 988 F.2d 1165, 1174 (Fed. Cir. 1993)).

By prosecuting narrower claims, while simultaneously disclosing the existence of alternatives not encompassed within those claims, petitioner precluded examination of those alternatives by the Patent and Trademark Office and unmistakably signalled to the public that she made no claim to them. Just as the public has the right to practice art surrendered by the patentee during the patent application process, the public should have the right to practice art that the patentee knew and disclosed in the patent but declined to claim.

II. THE DECISION OF THE FEDERAL CIRCUIT PRESENTS NO CONFLICT WITH *GRAVER TANK* OR ANY OTHER DECISION OF THIS COURT.

Petitioner argues that this Court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950), permitted the assertion of the doctrine of equivalents to equivalent subject matter disclosed in the specification but not included in the claims. Pet. at 11-14. As the Federal Circuit recognized below, however, the equivalents that this Court in *Graver Tank* permitted the patentee to assert *were* encompassed within claims in the patent. The pertinent claims, however, were held to be invalid after issuance. Under those circumstances, it did not make sense to infer any dedication to the public of equivalent alternatives that were not the subject of additional narrower claims. *See* 4 DONALD S. CHISUM § 18.02[3], at 18-14 to 18-15 (1996).[9]

It is no answer to argue, as petitioner does, that the majority in *Graver Tank* did not specifically advert to the existence of

[9] Professor Chisum explains that at the time of *Graver Tank*, the policy of the Patent and Trademark Office "restricted an inventor to no more than three species claims if a claim to a genus were allowed." *Id.* at 18-15. As a result, it might not have been possible, as a practical matter, for the patentee to include more particularized claims covering all the specific subject matter encompassed within the broader claim later found to be invalid.

invalid claims that encompassed the equivalent in question as a factor in its decision. The Court itself had upheld the invalidity of the broad claims in *Graver Tank* only the prior term. *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 336 U.S. 271 (1949). The Court in the second *Graver Tank* decision plainly did not intend to address every possible limitation or qualification to the doctrine of equivalents.[10]

Nor are cases like *Sanitary Refrigerator Co.* v. *Winters*, 280 U.S. 30 (1929), or *National Cash-Register Co.* v. *Boston Cash Indicator & Recorder Co.*, 156 U.S. 502 (1895), inconsistent with the Federal Circuit's decision below. In those cases, this Court considered patents drafted in a now obsolete fashion in which the patentee described the invention in the specification while claiming it in somewhat general terms "substantially as described" in the specification. *See* 280 U.S. at 32-38 (quoting patent); 156 U.S. at 507 (same). In that context, reference to the specification to determining the scope of the claims was not only understandable, it was essential. Modern patent practice, however, requires claims to be self-contained descriptions of the invention and claims that refer back to the specification are now rejected by the PTO. *See Ex parte Fressola*, 27 U.S.P.Q.2d 1608, 1608-11 (Bd. Pat. App. & Int. 1993), *rehearing denied*, 17 F.3d 1442 (Fed. Cir. 1994). Under modern patent practice it is clear that the specification cannot expand the scope of the claims.

The rule that unclaimed subject matter disclosed in a patent specification is dedicated to the public, like the doctrine of prosecution history estoppel, turns on an objective inquiry into what the public can reasonably infer from the text of a patent

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[10] The court did not, for example, refer to the doctrine of prosecution history estoppel, even though it had recognized that doctrine as a limitation on the doctrine of equivalents only eight years before. *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126 (1942).

and its prosecution history.[11] Where, as in *Graver Tank*, the patentee has in fact claimed the equivalent subject matter in a claim that has been examined and allowed by the PTO, but literal infringement is unavailable because the claim that covers the equivalent is later found to be invalid, the inference that there has been a dedication to the public is objectively unreasonable. But where, as here, the patentee made no attempt to claim subject matter that the patentee disclosed (and thus plainly knew), such an inference is not only reasonable, it is unavoidable.

III. The "Dedication to the Public" Rule Does Not Discourage Disclosure; Rather, It Encourages Identification of Inventions in Claims Subject to Examination as Patent Law Contemplates.

Petitioner attempts to buttress her meritless appeal to precedent with the same policy argument that she made to the Federal Circuit in her unsuccessful suggestion for rehearing in banc. She says that patent applicants, faced with a rule that dedicates to the public unclaimed subject matter set forth in the specification, will refrain from making such disclosures and thus impoverish

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[11] The prosecution history estoppel cases decided by the Federal Circuit make it clear that the scope of the estoppel is "an objective one, measured from the vantage point of what a competitor was reasonably entitled to conclude, from the prosecution history, that the applicant gave up to procure issuance of the patent." *Haynes International, Inc.* v. *Jessop Steel Co.*, 8 F.3d 1573, 1578 (Fed. Cir. 1993), *clarified on rehearing*, 15 F.3d 1076 (Fed. Cir. 1994). *See Mark I Marketing Corp.* v. *R.R. Donnelley & Sons Co.*, 66 F.3d 285, 291 (Fed. Cir. 1995), *cert. denied*, 116 S.Ct. 917 (1896); *Zenith Laboratories, Inc.* v. *Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir.), *cert. denied*, 115 S.Ct. 500 (1989). It is also a question of law for the court. *See Hoganas AB* v. *Dresser Indus., Inc.*, 9 F.3d 948, 952 (Fed. Cir. 1993). The Federal Circuit in this case clearly had such a standard in mind when it concluded, as a matter of law, that "[a] person of ordinary skill in the shoe industry, reading the specification and prosecution history, and interpreting the claims, would conclude that Maxwell, by failing to claim the alternate shoe attachment systems in which the tabs were attached to the inside shoe lining, dedicated the use of such systems to the public." Pet. at A13. In both situations, the issue is an objective one to be decided as a matter of law.

the contributions that patents make to the scientific literature. Pet. at 25-29. This argument cannot withstand scrutiny.

First, the patent act itself precludes patentees from playing their cards too close to the vest in drafting patent specifications. Section 112 provides that the specification

> shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 112.

More important, far from discouraging disclosures in patents, the "dedication to the public" rule encourages patent applicants to identify patentable inventions *in the claims*, where such identification belongs in a claims-based sytem. It tells patent applicants that if they have subject matter that they believe is novel, useful and non-obvious, they should include it in their claims and thus submit it to the PTO's examination process. What the rule discourages is an attempt to sneak the unclaimed alternatives into the specification without claiming them in the hopes of avoiding examination by the PTO and arguing infringement by equivalents to a jury later.

Petitioner counters by suggesting that no rational applicant would attempt to do so because they would have a much better chance of persuading the examiner to allow a claim in an *ex parte* process in the Patent and Trademark Office than of prevailing on a doctrine of equivalents claim in later adversary proceedings. Pet. at 26-27. This rejoinder is flawed for two reasons.

First, under the Federal Circuit's decision in *Hilton Davis Chemical Co.* v. *Warner-Jenkinson Co.*, 62 F.3d 1512, 1520 (Fed. Cir. 1995) (in banc) (*per curiam*), *cert. granted*, 116 S.Ct. 1014 (1996), application of the doctrine of equivalents is a question of fact that may be submitted to the jury in an infringement action. If the patentability of subject matter is questionable, a patent applicant may well conclude that she stands a better chance with a jury than with an expert examiner.

Second, petitioner ignores the practical consequence of having an issued patent. Many competitors will license a patent, even though their competing technology may not literally infringe, because that course may be less expensive and less uncertain than infringement litigation. This is particularly true because the outcome of a doctrine of equivalents inquiry is so difficult to predict as the doctrine is currently applied. As a result, a patent applicant with a range of inventions, some of which are of doubtful patentability, could well conclude that her economic interests may be best served by claiming only those narrow alternatives where patentability is reasonably clear and making a broader disclosure in the specification. Threatening infringement litigation against those who practice the disclosed but unclaimed alternatives may produce a tidy royalty stream or valuable cross-licenses from those for whom the costs and uncertainties of litigation are either prohibitive or uneconomical.

It is worth pointing out that this is the course that petitioner herself pursued. She claimed narrowly, but disclosed broader alternatives in her specification. She demanded licenses from virtually every company in the shoe industry that connected unboxed shoes through tabs located anywhere inside the shoes. She has played this game shrewdly, but not in accordance with the rules that Congress has ordained because she seeks patent rights for alternatives that she deliberately insulated from examination by the Patent and Trademark Office. The Federal Circuit properly rejected this strategy.

Even if, however, petitioner had failed to claim a patentable invention through inadvertence, Congress has specified the proper remedy: reissue. As the court below noted, Pet. at A12 n.2, section 251 of the patent act authorizes the reissuance of a patent with broader claims within two years of the issuance of the original patent, if in the original patent the patentee "claim[s] . . . less than he had a right to claim in the patent." 35 U.S.C. § 251. So here, not only was there nothing stopping petitioner from claiming at the outset a shoe connection system involving tabs located anywhere within the interior of the shoe, she also had the opportunity even after the patent issued to seek broader claims on the same disclosure. In both instances, however, an expert patent examiner would have reviewed the broader claims against crowded prior art. It was this review that petitioner sought to avoid.

IV. The Pendency of This Court's Decision in *Warner-Jenkinson* Should Not Warrant a Grant of Review In This Case Because the Issue Raised By Petitioner Is Not Presented In This Case.

Perhaps recognizing the weakness of her argument on the merits, petitioner suggests that the Court defer acting on her petition pending the decision of this Court in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, No. 95-728. However, the issue raised in the instant petition — whether the disclosure of subject matter in a patent specification constitutes a dedication to the public precluding the application of the doctrine of equivalents — is not presented in *Warner-Jenkinson*. There is no suggestion in that case that the patentee disclosed in the specification the allegedly equivalent subject matter practiced by the defendant as an alternative to the claimed invention. To be sure, there is a dispute over prosecution history estoppel in *Warner-Jenkinson*. Petitioner in neither that case nor the instant

case claims, however, that prosecution history estoppel should not continue as a settled limitation on the doctrine of equivalents.[12]

Petitioner here relies instead on the fact that Warner-Jenkinson has argued in the alternative that the doctrine of equivalents should be limited to situations in which the claimed equivalent was disclosed in the specification.[13] A review of Warner-Jenkinson's brief makes it clear, however, that this argument is merely an invitation to this Court to limit its *Graver Tank* decision to its facts, as an alternative to overruling it. This invitation appears in the context of an argument that the doctrine of equivalents itself is ill-considered and has no place in a claims-based patent system. Warner-Jenkinson nowhere addresses the many statements in many cases that unclaimed subject matter disclosed in a patent specification is dedicated to the public.

Moreover, as the Federal Circuit recognized in this case, Pet. at A12-A13, the strict holding of *Graver Tank* is that the doctrine of equivalents applies where the patentee has *both* disclosed the equivalent subject matter in the specification *and* included it in a claim that had been examined and allowed by the PTO. As discussed above, both factors must be present to make the "dedication to the public" rule inapplicable. Since petitioner never claimed the alternatives adopted by J. Baker in any claim examined by the PTO, limiting *Graver Tank* to its facts would not help her here.

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[12] J. Baker did not argue to the Federal Circuit, as petitioner implies, that rehearing in banc by the Federal Circuit should be denied because this Court was likely to address the "dedication to the public" rule in *Warner-Jenkinson*. On the contrary, J. Baker emphasized in its opposition to rehearing that that issue was not presented in *Warner-Jenkinson*. J. Baker merely suggested that the Federal Circuit might not wish to devote scarce resources to in banc review of any case involving the doctrine of equivalents until this Court completed its review of the doctrine in *Warner-Jenkinson*.

[13] The Federal Circuit recently rejected this argument in *Pall Corp.* v. *Micron Separations, Inc.*, 66 F.3d 1211, 1220 (Fed. Cir. 1995).

CONCLUSION

For the foregoing reasons, the petition should be denied.

Respectfully submitted,

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